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EXAMINER
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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

	Application No.	Applicant(s)	
Office Action Summary	09/190,727	PALTENGHE ET AL.	
	Examiner	**Art Unit**	
	Richard W. Hess	2764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1) ☒ Responsive to communication(s) filed on _12 November 1998_ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-21_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1–21_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _12 November 1998_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:

        1. ☐ received.

        2. ☐ received in Application No. (Series Code / Serial Number) _____ .

        3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) ☒ Notice of References Cited (PTO-892)
15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

17) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
18) ☐ Notice of Informal Patent Application (PTO-152)
19) ☐ Other: .

DETAILED ACTION

1.   Claims 1–21 have been examined.

Drawings

2.   The drawings are objected to because of the minor informalities cited on the attached form PTO 948. Correction is required.

3.   Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Claim Objections

4.   Claims 1, 11–16 and 18 are objected to because of the following informalities:

Claim 1 contains the phrase "... means company moderately dynamic personal data..." which does not make sense. The examiner will assume that the applicant meant to have the word "comprising" instead of the word "company".

In line 7 of claim 11, the applicant states that the *second* data store is made up of data comprising dynamic demographic information data about the user having access to the third data store. The word "second" makes this portion of the claim confusing, because in line 5 of this claim the applicant states that "moderately dynamic personal data is stored in the second data store. The examiner will assume that the applicant meant to have the word "third" instead of the word "second" in line 7 of this claim.

Claims 12–16 and 18 are dependent claims that currently refer back to claim 1 instead of back to independent claim 11, which the examiner believes was the applicant's intent.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6.   Claims 1–3, 5–8, 10, 11, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Neil et al, US Patent No. 5,987,440.

As per claim 1, O'Neil et al explicitly teaches a system for the selective control of the organization, use and access to personal data. This system uses a server (column 4, lines 25–26) and has a means for storing personal data in a plurality (including three) of distinct data stores (column 10, lines 23–26, Figure 29 and column 10, lines 56–60). The applicant states that the first data store is called the "static identification data" and contains such information as name, address, phone number, social security number and other such personal information (page 3, lines 23–29). O'Neil et al teaches that a member of his system has an informational identity encapsulated within its memory (column 2, lines 16–33) and this informational identity contains information

characterized by the applicant as "static identification data" (column 7, line 53 through

column 8, line 3). Therefore, O'Neil et al teaches that his personal information system

has a first data store that stores static identification data, which is personal to a user

having a means to access the system server as claimed by the applicant.

The applicant also states that the second data store is intended to mean

"moderately dynamic personal data" and contains such data as billing history, payment

history, loans, real estate holdings, stock, bond, fund holdings, medical records, home

web pages and the like (page 4, lines 1–5). O'Neil et al teaches that a member of his

personal information system can interact with other members within that system obtain

information from sources external to the immediate system (column 2, lines 56–64).

O'Neil et al teaches further that his system contains health, financial, legal records,

school transcripts and employment history (column 10, lines 23–26), so O'Neil et al

teaches a second data store for storing moderately dynamic personal data about the

user as claimed by the applicant.

Finally, the applicant states the third data store contains "dynamic demographic

information data" and is characterized by including such data as user interests, user

profiles and user agents. The applicant goes on to state some examples of the type of

data contained in this group of personal information, such as age, geographic location,

race, religion, professional interests, hobby interests, frequent purchase categories,

explicit requests for information and explicit requests for blocking categories of

information. The applicant also states that access to this information can be marketed

or sold for a fee (page 4, lines 10–19). O'Neil et al clearly shows the storage and use of "dynamic demographic informational data" and the control of access to this information in Figures 29–33 as claimed by the applicant. O'Neil et al goes on to teach that access to this information can be sold, marketed or licensed for a fee (column 6, lines 53–64), so O'Neil et al also teaches a third data store for storing dynamic demographic information about the user as claimed by the applicant.

In describing the three data stores, the applicant describes the characteristics of the information and how it is used without placing any limitations on the techniques or manner in which the information is stored, so the examiner will assume that any technique or manner known at the time of the invention can be used to store the personal information stated by the applicant.

Claim 1 is, therefore, rejected because O'Neil et al teaches all the limitations claimed by the applicant.

As per claims 2 and 3, O'Neil et al teaches a selective personal information control system that has the means for connecting to a server used to access the first, second, third and more data stores and explicitly discloses the use of a computer terminal connectable to the server via a network (Figure 7, particularly #45) as claimed by the applicant.

As per claim 5, O'Neil et al explicitly teaches a means for authorizing and allowing selected users access to and use of dynamic personal information data in the third data store (column 6, lines 53–64).

As per claim 6, O'Neil et al explicitly discloses a means for matching selective dynamic personal information data in the third data store which is specific to a consumer with selected information provided by selected users (column 13, lines 22–35) as claimed by the applicant.

As per claim 7, O'Neil et al discloses a means for authenticating and signing documents for a user from data obtained from the second data store in communicating with a user as claimed by the applicant (column 9, lines 27–55).

As per claim 8, O'Neil et al teaches a means for matching a user profile obtained form the third data store, with the merchant profile, upon user request, for transmitting information about the merchant's products to the user (column 13, line 64 through column 14, line 14).

As per claim 10, O'Neil et al explicitly teaches an event logger capability to keep track of payment history, credit card transactions and other transfer of money or value that can be used in a commercial transaction as claimed by the applicant (column 21, lines 37–62).

Claim 11 is a method claim containing the same limitations as in claim 1, so the same rejection applies.

As per claim 18, O'Neil et al explicitly teaches that his personal information security and exchange tool maintains strict control over the dissemination of personal information and only allows access to selected third parties that are authorized to

access the data stored in the system, including the data in the second data store

(column 16, line 36 through column 17, line 13).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 4, 13, 15 and 19–21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over O'Neil et al and Pitroda, US Patent No. 5,884,271.

As per claim 4, O'Neil et al discloses a software and hardware system for a user

to author, secure, search, exchange and process personal information in a trusted and

controlled manner (column 1, lines 11–14). O'Neil et al, however, does not disclose the

use of an electronic wallet to store duplicates of data stored in the first data store and

portions of the data stored in the second and third data store as claimed by the

applicant. On page 8 of the specification, the applicant defines an electronic wallet as a

virtual container for various information and financial applications the user might want to

be mobile. The applicant goes on to suggest that a "smartcard" is one example of an

implementation of this feature. Pitroda teaches the use of a "smartcard" he calls a

universal electronic transaction card (UET card) that stores a duplicate of the first data

store (column 2, lines 51–51), portions of the second data store (column 2, lines 55–60)

and portions of the third data store (column 3, lines 34–40) as claimed by the applicant. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of O'Neil et al with the electronic wallet taught by Pitroda for the advantage of providing a software and hardware system that is easy to carry and allows a user to author, secure, search, exchange and process personal information in a trusted and controlled manner.

Claim 13 is a method claim containing the same limitations as in claim 4, so the same rejection applies.

As per claim 15, O'Neil et al teaches the control of financial transactions involving the transfer of money or other form of value. O'Neil et al does not explicitly teach the downloading of this money or value to an electronic wallet to allow a user to engage in commercial transactions with the credits. Pitroda explicitly discloses the downloading of promotional coupons, usage incentives, cash back rebates and various other incentives into his electronic wallet (column 3, lines 34–40). Pitroda also teaches that his card is used to conduct commercial transactions with these credits (column 3, lines 41–53). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of O'Neil et al with the capabilities of the electronic wallet taught by Pitroda for the advantage of having a light weight and portable way to spend accumulated purchasing credits.

As per claims 19–21, O'Neil et al discloses that health, financial, legal, education, employment and other forms of information is included in the data contained in the

personal information system (column 23–26). O'Neil et al, however, does not explicitly disclose that doctors, financial service providers, insurance vendors and credit card providers are allowed access to this personal information. Pitroda explicitly teaches that his universal transaction card is capable to authorizing the transfer of personal information to doctors, financial service providers, insurance vendors and credit card providers (column 2, lines 60–65) as claimed by the applicant. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of O'Neil et al by including the ability for doctors, financial service providers, insurance vendors and credit card providers to access the personal information of the user as taught by Pitroda for the advantage of providing an easily transportable and secure method for sharing this information with businesses that supply products or services to the owner of the personal information.

Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al and Walker et al, US Patent No. 5,884,270.

As per claim 9, O'Neil et al teaches that users of his personal information system can assign access rules to each piece of personal information stored in his system (column 2, lines 34–36). He teaches further that these rules can be used to make the user's personal information (third data store) available to marketing firms for a fee (column 6, lines 53–64) and goes on to teach that his system controls access to a member's personal information even to the point of denying access to the personal information if the inquiry does not meet the members disclosure rules (column 13, line

53 through column 14, line 14). O'Neil et al, however, does not explicitly teach storing the information in a configuration ensuring user anonymity. Walker et al teaches a method and system for electronic–based anonymous communication that uses a central database to store the personal information (column 4, lines 17–25). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of O'Neil et al by including the anonymous communication rule taught by Walker et al for the advantage of protecting the privacy of the owner of the personal information stored in the database. An example of a way people commonly protected their anonymity in communication is an unlisted phone number. Other examples are given in columns 1 and 2 of Walker et al patent.

Claim 14 is a method claim containing the same limitations as in claims 5,8 and 9, so the same rejections apply.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al and DeFrancesco et al, US Patent 5,878,403. O'Neil et al teaches that first data store personal information is used to open accounts (memberships) in other data store environments by simply copying the first data store information to the new environment (column 12, lines 33–54). O'Neil et al does not explicitly state that this information is used to fill out forms. DeFrancesco et al, however, teaches a computer implemented automated credit application system that automatically enters the credit application information directly into the lenders information system, so the lender does not have to manually enter the application data (column 5, lines 24–27). DeFrancesco et al also

teaches that his system can produce paper versions of the credit application form that is

standard for the lender (column 5, lines 10–19). It would have been obvious to a person

of ordinary skill in the art at the time of the invention to modify the teachings of O'Neil et

al with the automatic form filling capability of DeFrancesco et al to obtain the invention

as claimed by the applicant. The obvious advantage would be to speed up the process

of filling out credit application forms and the reduction or elimination of manual entry

errors.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable

over O'Neil et al and Walker et al US Patent No. 6,018,718. As stated before, O'Neil et

al teaches the use of agents that interact with subsets of personal data in any manner

determined by the rules setup by the user (column 2, lines 56–63). O'Neil et al also

teaches that his system can handle event logging and credit card and other settlement

transactions (column 21, lines 37–39). O'Neil et al teaches further that individual users

can define their own billing policies (column 21, lines 51–52) and his system can

monitor all financial transactions and create accurate billing and financial summaries

(column 21, lines 60–62). O'Neil et al does not explicitly disclose accessing outside

data sources to update the personal data stores on a periodic basis and the monitoring

of certain groups of personal data for the occurrence of certain events, and notifying a

user the corresponding event happens. Walker et al, however, explicitly discloses a

method for processing customized award offers that includes the periodic accessing

and updating of the second and third data store information from outside sources and

monitoring certain groups of data for the occurrence of certain events. He also discloses notifying the user when the monitored events occur (column 3, lines 11–42). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of O'Neil et al with the periodic update of personal data from outside sources and the monitoring and notification capabilities taught by Walker et al to get the invention as claimed by the applicant. The advantage for the users of the O'Neil et al system would be a quicker response to the reward or incentive offers, before they expire. The advantage for the outside data sources would be to increase the effectiveness of their incentive awards.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Experton, US Patent No. 5,995,965, Motoyama, US Patent 5,913,202, Everett et al, PCT WO 98/52159, Hoshino, European Patent No. EP 0 908 855 A2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard W. Hess whose telephone number is (703) 308-6287. The examiner can normally be reached on M-F (7:00-4:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

308-9051 for regular communications and (703) 308-5357 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

FRANTZY POINVIL
PRIMARY EXAMINER
AU 2768

February 7, 2000